

Winter and Charrier are relied upon as in the previous Office Action. The Examiner recognizes that Winter does not specifically disclose the amount of ethylene in the EMA or EVA layer as recited in claim 1.

To remedy this deficiency the Examiner relies on Charrier for the disclosure that commonly sold EVA polymers contain 55-60% ethylene units, which is within the claimed range. It is the Examiner's position that it would have been obvious to one of ordinary skill in the art to use a commonly sold EVA polymer in the invention of Winter to suitably bond the backing layer in the film shown in Winter to the sealing layer.

Applicants note that in paragraph 7 on page 6 of the Office Action, the Examiner states that the reference to the use of the disclosed products in Charrier is for CSPE rubbers and not for EVA. In support thereof the Examiner has provided the page from Charrier (page 204) that precedes page 205, which was previously provided.

However, Applicants traverse the rejection and maintain that the Examiner has not made a *prima facie* showing of obviousness since there is no motivation to combine or modify the disclosure of the references. There is no teaching in either of the references which would lead one of ordinary skill in the art to specifically select an EVA copolymer having an ethylene content within the recited range. The fact that some commercial EVA rubbers contain about 60-65% ethylene does not mean that all commercially sold EVA rubbers have an ethylene content within the claimed range and therefore it is not sufficient to establish motivation to modify or combine the references. The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, it has not been established on the record that the prior art suggests the desirability to modify or combine disclosures.

Accordingly, Applicants respectfully request withdrawal of the rejection.

**B. Genske et al in view of Wilham et al and Charrier**

In paragraph 4 on page 4 of the Office Action, claims 1 and 3-7 are rejected as allegedly being unpatentable over Genske et al in view of the combined teachings of Wilham et al and Charrier.

Genske et al is relied upon for the disclosure of a multilayer film suitable for use as lidstock in a food packaging application, which includes a sealing layer and an adjacent layer that can include EVA or EMA.

The Examiner recognizes that Genske et al does not teach that the sealing layer comprises polyester or that the polyester layer has the specific thickness recited in claims 1 and 5 or the specific amount of ethylene recited in claim 1. To remedy these deficiencies, the Examiner relies on Wilham et al and Charrier.

Wilham et al is relied upon for the disclosure of a peelable sealing film in which the sealing film is made from polyester and has a thickness within the recited range, and which is applied to packaging applications. The Examiner further relies on Wilham for the teaching that it is advantageous to use the disclosed composition for a sealing layer because it adheres to a substrate at relatively low temperatures.

Charrier is relied on for the disclosure that commonly sold EVA polymers contain 55-60% ethylene units, which is within the claimed range.

It is the Examiner's position that it would have been obvious to one of ordinary skill in the art to use a commonly sold EVA polymer (as taught by Charrier) in the invention of Genske et al to form a structure analogous to the disclosed structure taught by Genske et al. The Examiner further states "it would have been obvious to one of ordinary skill in the art to combine Charrier with Genske et al and Wilham et al to obtain the part of the invention as specified in claim 1."

The Examiner further states that it would have been obvious to a person of ordinary skill in the art to use a polyester sealing layer in the invention shown in Genske et al to provide a heat sealing layer that is sealable at low temperatures. The Examiner states that "it would have been obvious to combine Wilham et al with Genske et al and Charrier to obtain the invention as specified in claims 1 and 3-7.

In response to the arguments previously made with respect to Genske et al, the Examiner takes the position that Genske et al does not teach away from the claimed invention and that Genske et al does not require the composition of the sealing layer to be different from the claimed invention. See the Office Action page 6, paragraph 8.

Applicants respectfully traverse the rejection. Applicants disagree with the Examiner's interpretation of Genske et al and submit that the Examiner has not made a *prima facie* showing of obviousness. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. Further, the Examiner must weigh the suggestive power of each reference, *In re Young*, 927 F.2d 588 (Fed. Cir. 1991), and consider the reference as a whole including portions that teach away from the claimed invention. *W.L. Gore*

*& Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

In this case, when viewed as a whole, Genske et al teaches away from the claimed invention as previously argued. In addition to the disclosure at col. 3, lines 39-43 previously discussed in the Amendment filed on November 18, 2002, Applicants note that Genske et al teaches that for retort applications, the container or base film are often polypropylene or polyethylene based and the outer sealant layer should include a predominance of polyethylene or polypropylene to match the predominance in the container or base film. Col. 3, lines 55-59. In addition, Genske et al discloses that outer sealant layer 20 is sealed to the container. See Col. 4, line 40 and Fig. 4. It is also disclosed that the composition of the container 16 and the outer sealant layer 20 are substantially similar to one another so that the heat sealing creates a sealing interface between the two layers so that the layers function as a single layer in the area of the seal. Col. 4, lines 61-66. The container is disclosed as being an injection molded polyethylene, polypropylene or a thermoformed laminate which comprises a barrier layer, adhesives, and an outer polymer layer. Col. 4 line 67 to col. 5, line 3. The outer sealant layer is disclosed as being any suitable material that adheres to the container. However for food applications it is noted that FDA regulations limit the outer sealant layer to polyolefins and certain percentages of other compositions such as polyisobutylene. Col. 5, lines 22-29. Thus, when viewed as a whole Genske et al strongly suggests a polypropylene or polyethylene outer sealant layer and teaches away from a polyester outer sealant layer as recited in the claims.

Even if Genske et al is not considered to teach away from the claimed invention, there is no motivation or suggestion to modify or combine Genske et al with the disclosure of Wilham et al as suggested by the Examiner. Wilham et al is concerned with a heat sealable polyester packaging film that produce a peelable seal when heat sealed to itself and other polyester materials. See paragraphs 001 and 0012. There is no disclosure regarding an adjacent EVA or EMA layer. Thus, in view of the discussion above with respect to the disclosure of Genske et al teaching away from the claimed invention in suggesting polypropylene or polyethylene sealing layers sealed to containers made of substantially the same material, one of ordinary skill in the art would not have had a reasonable expectation of achieving the claimed invention based upon the disclosures of Genske et al and Wilham et al.

Charrier does not cure the deficiencies of Genske et al and Wilham et al with respect to the recited polyester sealing layer. Further, there is no teaching in any of the references which would lead one of ordinary skill in the art to specifically select an EVA copolymer having an ethylene content within the recited range. The fact that some commercial EVA rubbers contain about 60-65% ethylene does not mean that all commercially sold EVA rubbers have an ethylene content within the claimed range and therefore it is not sufficient to establish motivation to modify or combine the references.

Further, the Examiner's statement that "it would have been obvious to one of ordinary skill in the art to combine Charrier with Genske et al and Wilham et al to obtain the part of invention as specified" is based on improper hindsight. The proper inquiry is whether the

references teach or suggest the claimed invention when viewed as a whole and not “a part” of the invention.

**C. Genske et al in view of Winter and Charrier**

In paragraph 5 on page 4 of the Office Action, claims 1 and 3-7 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Genske et al in view of the combined teachings of Winter and Charrier. Each of Genske et al, Winter and Charrier are relied upon as previously discussed.

The Examiner recognizes that Genske et al does not teach or suggest a polyester sealing layer or the recited thickness of the polyester sealing layer. To remedy this deficiency, Winter is relied upon for the disclosure of a sealing film made of polyester having a thickness within the recited range and for the teaching that it is advantageous to use the sealing layer of Winter for films suited for high temperature applications.

The Examiner also recognizes that Genske et al does not teach the amount of ethylene present in the EVA or EMA layer as claimed. To remedy this deficiency the Examiner relies on the disclosure of Charrier that commonly sold EVA copolymers contain 55-60% ethylene units. It is the Examiner's position that it would have been obvious to one of ordinary skill in the art to use a commonly sold EVA polymer in the invention of Genske et al to form a structure analogous to the one taught in Genske et al and therefore it would have been obvious to combine Charrier with Genske et al and Winter to obtain that part of the invention as specified in claim 1.

The Examiner further concludes that it would have been obvious to a person of ordinary skill in the art to use a polyester sealing layer in the invention shown in Genske et al to provide a

multilayer sealing film that is suited for use at high temperatures and therefore it would have been obvious to combine Winter with Genske et al and Charrier to obtain the invention as specified in claims 1 and 3-7.

Applicants respectfully traverse the rejection and submit that the Examiner has not made a *prima facie* showing of obviousness.

Genske et al teaches away from the claimed invention for the reasons stated above. Even if Genske et al is not considered to teach away from the claimed invention, there is no motivation or suggestion to modify or combine Genske et al with the disclosure of Winter as suggested by the Examiner. Winter teaches that the function of the heat sealant polyester layer is to serve as a heat sealant layer when the film is sealed to itself or to a second substrate. Col. 6, lines 28-30. However, there is no disclosure of any particular second substrate. Throughout the entire disclosure of Winter, the disclosed film is taught as being useful as a liner for a microwave popcorn bag. See Abstract; col. 4, lines 2-4, lines 6-12, lines 23-25; col. 5, lines 24-38; Figures 3A, 3B, and 4; and Examples 8, 9 and 10). Thus, Winter would reasonably suggest to one of ordinary skill in the art that the heat sealant layer is laminated to itself or other substrates commonly used in popcorn bags or similar applications, such as paper. Therefore, in view of the discussion above with respect to the disclosure of Genske et al teaching away from the claimed invention in suggesting polypropylene or polyethylene sealing layers sealed to containers made of substantially the same material, one of ordinary skill in the art would not have had a reasonable expectation of achieving the claimed invention based upon the disclosures of Genske

et al and Winter which teaches a polyester heat sealant layer sealed to itself or a second substrate used in microwave popcorn bags.

Charrier does not cure the deficiencies of Genske et al and Winter with respect to the recited polyester sealing layer. Further, there is no teaching in any of the references which would lead one of ordinary skill in the art to specifically select an EVA copolymer having an ethylene content within the recited range. The fact that some commercial EVA rubbers contain about 60-65% ethylene does not mean that all commercially sold EVA rubbers have an ethylene content within the claimed range and therefore it is not sufficient to establish motivation to modify or combine the references.

**III. The Examiner's Response to the Arguments in the Amendment filed on November 18, 2002.**

On pages 6-7 of the Office Action, the Examiner addresses the arguments made in the Amendment filed on November 18, 2002, which have been addressed above in view of the rejections. Applicants believe they have earlier replied to the Examiner's position.

**IV. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116  
U.S. Application No.: 09/987,163

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Respectfully submitted,


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